

Application No. 09/905,719
Reply to Office Action dated February 20, 2003

Docket No. P24,624-A USA

REMARKS

I. Summary of the Office Action and this Reply

Claims 22-44 are pending in the application. Applicants gratefully acknowledge the Examiner's recognition of allowable subject matter in claims 28-30, 32 and 29-41, stating that such claims are would be allowable if rewritten in independent form. The Examiner has rejected claims 22-27, 31, 35-38, 43 and 44 under 35 U.S.C. § 103(a), asserting that such claims are unpatentable as obvious over U.S. Patent No. 3,746,064 to Nakazaki ("Nakazaki") in view of U.S. Patent No. 6,427,343 B1 to Chang ("Chang").

The Examiner has objected to the specification, noting informalities with respect to the use of reference numeral 62.

In this Reply, claims 22, 31, 35, 38 and 42 are amended. Claims 43 and 44 are canceled. Claims 45 and 46 are added. No new matter is added. Support for the claim amendments and new claims can be found, *inter alia*, in the drawings as originally filed.

II. Objections to the Specification

The Examiner has noted that the specification as originally filed used reference numeral 62 to denote two different items. Accordingly, the specification is amended herein at page 7, line 20 for clarity.

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III. Formalities

It is noted that the present non-provisional patent application is the result of conversion of a U.S. Provisional Patent Application No. 60/293,471, filed May 24, 2001. Accordingly, the present application is entitled to the May 24, 2001 filing date and it is believed that the application filing date reflected on the Official Filing Receipt, Office Action dated February 20, 2003, etc. should be amended accordingly. 37 CFR 1.53(c)(3).

It is further noted that, as the result of cancellation of claims herein, Phillip Bruce Daley, Jr. should no longer be identified as an inventor. A Request to Correct Inventorship under 37 CFR 1.48(b) is filed herewith requesting deletion of Phillip Bruce Daley, Jr. as an inventor.

IV. Response to 103 Rejections

The Examiner has rejected claims 22-44 under 35 U.S.C. § 103(a), asserting obviousness over Nakazaki in view of Chang. Claims 43 and 44 have been canceled.

A section 103 rejection is proper only if all claim limitations are taught or suggested by the prior art. MPEP § 2143.03. Moreover, even if all elements are found in the cited art, there still must be motivation in the cited art to make the proposed combination.

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A. Discussion of the Cited Art

U.S. Patent No. 3,746,064 to Nakazaki

Nakazaki discloses an electric pencil sharpener having a cutter holder rotatably mounted in a casing including a lower casing 21 and an upper casing (not shown) removably secured thereto. The lower casing 21 houses a sharpener unit 22 having a driving means 23 and a cutting means 24. Col. 2, lines 53-58. The sharpener unit 22, including the induction motor 28, etc. is attached to the lower casing 21 by screws. Figure 2; col. 2, lines 58-67.

The Examiner acknowledges that Nakazaki does not disclose first and second shells having internal ribs defining a first plurality of support surfaces to retain a sharpening sub-assembly within the shells.

The Examiner asserts that it is inherent that Nakazaki provides a retaining/securing means within the shells so as to hold the sharpening means securely in position within the casing and asserts that it would have been obvious to replace Nakazaki's mounting/retaining means with ribs.

U.S. Patent No. 6,427,343 B1 to Chang

Chang discloses a manual pencil sharpener including a housing 10 having two half members enclosing a casing 20. The casing 20 supports a cutter blade 23 and has an opening 21 for receiving a pencil to be sharpened 50. Abstract; col. 2, lines 22-39; Figure 2.

An inside wall of at least one half member of the housing 10 includes ribs 19.

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The ribs 19 extend inwardly of a chamber 11 of the housing 10 for receiving and retaining the casing 10. Col. 2, lines 26-30; Figures 2-4.

B. Neither Nakazaki nor Chang, alone or in combination, provide
Motivation to Combine to Arrive at the Claimed Invention

With respect to claims 22, 23, 24, 35, 36, 37 and 42, the Examiner simply asserts that it would have been obvious to modify the teachings of Nakazaki, and more specifically, to modify the teachings of Nakazaki in accordance with the asserted teachings of Chang, to arrive at the claimed invention. The Examiner has not cited any motivation in Nakazaki or Chang for making such a modification. Instead, the Examiner has used impermissible hindsight in asserting motivation. The U.S. Court of Appeals for the Federal Circuit has recently emphasized that motivation must be "based on objective evidence of record."¹ See *a/so* MPEP 2143.01. There is no objective evidence of record, particularly in Nakazaki or Chang, providing the asserted motivation.

Additionally, the proposed modification is not of a type for which there is motivation as a mere design choice, e.g. to interchange equivalent fasteners. Instead the structures and principles of operation are entirely different, and would require substantial modification of molds for molding the shells. There is no motivation in the cited references for making such drastic modifications.

¹ *In re Sang-Su Lee*, 277 F.3d 1338, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002).

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For at least this reason, reconsideration and withdrawal of the rejection of claims 22 - 42 is respectfully requested.

C. Not all Claim Limitations are Taught or Suggested by the Cited Art

Even if there were motivation to combine the teachings of Nakazaki and Chang, neither Nakazaki nor Chang, alone or in combination, teaches or suggests all claim limitations, as discussed below.

Claims 22-27

Amended independent claim 22 is directed to a pencil sharpener including first and second longitudinally elongated external shell(s), each having internal ribs defining support surfaces. The pencil sharpener further includes a sharpening sub-assembly for sharpening a pencil.

Amended claim 22 expressly recites that the support surfaces cooperate with each other to laterally position and fixedly retain said sharpening sub-assembly within said shells."

The Examiner acknowledges that Nakazaki is devoid of any disclosure of first and second shells having internal ribs defining support surfaces. Chang neither teaches nor suggests that the support surfaces cooperate with each other to laterally position and fixedly retain said sharpening sub-assembly within said shells. Although Chang discloses a housing half having internal ribs 19, those ribs serve only to limit vertical (up and down) and longitudinal (in the direction of elongation of

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the pencil sharpener housing, i.e. generally in the direction of insertion of the pencil) movement of the casing 20. Accordingly, such ribs 19 do not have support surfaces that laterally position and fixedly retain any sharpening components. Rather, it is the internal surfaces of the housing halves, if anything, of Chang's pencil sharpener that perform any lateral positioning function. This is an entirely different principle of operation from that of the claimed invention. Modifying the ribs of Chang to move them to the sides of the casing 20 would change the principle of operation of Chang and render Chang's pencil sharpener inoperable for its intended purpose because the casing 20 would no longer be longitudinally or vertically fixed for use to sharpen pencils. For this additional reason, reconsideration and withdrawal of the rejection of claim 22 is respectfully requested.

Claims 23-27 depend from claim 22 and are likewise believed patentable. In addition, claim 23 recites that the "first and second pluralities of support surfaces serve as the sole means of mounting the sharpening subassembly in said compartment." In Chang, the ribs 19 serve to support the casing 20 only against longitudinal and vertical movement. The internal surfaces of the housing 10 halves serve to support the casing 20 against lateral movement. Accordingly, the ribs of Chang do not have support surfaces that "serve as the sole means of mounting the sharpening subassembly" in the housing, as recited in claim 23. Therefore, Nakazaki and Chang fail to teach or suggest all limitations of claim 23. For at least this additional reason, reconsideration and withdrawal of the rejection of claim 23 is respectfully requested.

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Claim 31

Dependent claim 31 depends from claim 22 and are therefore likewise believed patentable for the reasons set forth above for claim 22.

Additionally, claim 31 recites that a dual switch is operatively connected to the pencil sharpener's electric motor for driving the sharpening sub-assembly only when the dual switch is activated by: (1) a pencil inserted into the pencil-receiving opening of the pencil sharpener's housing; and (2) a receptacle mated with said first and second external shells. Claim 31 has been amended to clarify this relationship. Accordingly, due to the nature of the dual switch, the motor and sharpening sub-assembly will not be operable unless a pencil is inserted into the sharpener and a receptacle is mated with the pencil sharpener housing. Specification, page 3, line 22 - page 4, line 3; page 10, lines 1-10.

Contrary to the Examiner's assertion on page 3 of the Action, Nakazaki fails to disclose the claimed invention. In contrast, Nakazaki discloses a switch arrangement for activating a motor when a pencil is inserted into a sharpener, for turning off the motor when the pencil is sharpened, and for illuminating a light indicating that the pencil has been sharpened. Nakazaki, col. 3, lines 44-63; col. 4, lines 11-36; col. 4 line 49 - col. 5, line 12. Nakazaki is devoid of any disclosure of a switch activated by mating of a receptacle to a pencil sharpener housing.

For at least these additional reasons, reconsideration and withdrawal of the rejection of claim 31 is respectfully requested.

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Claims 33 and 34

Dependent claims 33 and 34 depend from claim 22 and are therefore likewise patentable for the reasons set forth above for claim 22.

Additionally, it is noted that the Examiner has acknowledged claim 32 as allowable. See page 4 of the Action. Dependent claims 33 and 34 depend from allowable claim 32 and therefore are likewise allowable.

For these reasons, reconsideration and withdrawal of the rejection of claims 33 and 34 is respectfully requested.

Claims 35-37

Amended independent claim 35 is directed to a pencil sharpener including a cutter assembly and cutter gear module. The pencil sharpener also includes first and second external shells. Each shell includes internal ribs. Each rib has a first side and a second side opposite the first side. Both sides adjoin a respective shell. Each rib defines a support extending between a respective first and second side of a respective rib. Accordingly, each rib extends laterally of the shell, and the support surface is positioned to provide lateral support to a pencil sharpener component. Claim 35 further recites that the support surfaces cooperate with each other to engage and retain the cutter assembly and gear module in a compartment of the shells.

As discussed above with reference to claim 22, Nakazaki is devoid of any disclosure of shells having any internal ribs. Chang discloses a housing half having

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internal ribs 19 serving only to limit vertical (up and down) and longitudinal (in the direction of elongation of the pencil sharpener housing, i.e. generally in the direction of insertion of the pencil) movement of the casing 20.

Chang neither teaches nor suggests the claimed arrangement, in which each rib defines a support surface extending between respective first and second sides of the rib such that the support surfaces can laterally position and fixedly retain the sharpening sub-assembly within the shells. Rather, it is the side surfaces of the ribs in Chang that provide any such support. It is the internal surface of the housing halves, if anything, of Chang's pencil sharpener that performs any lateral positioning/ supporting function. There is no motivation in either Nakazaki or Chang to modify their teachings to arrive at the present invention. Accordingly, reconsideration and withdrawal of the rejection of claim 35 is respectfully requested.

Claims 36 and 37 depend from claim 35 and are likewise patentable.

Claim 38

Claim 38 depends from claim 35 and is therefore likewise patentable for the reasons set forth above for claim 35. In addition, claim 38 recites that the pencil sharpener includes a dual switch for driving the sharpening sub-assembly only when the dual switch is activated by: (1) a pencil inserted into the pencil-receiving opening of the pencil sharpener's housing; and (2) a receptacle mated with said first and second external shells. Claim 38 has been amended to clarify this relationship.

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Accordingly, claim 38 is patentable for reasons similar to those set forth above for claim 31. Reconsideration and withdrawal of the rejection of claim 38 is therefore respectfully requested.

Claim 42

Independent method claim 42 has been amended to recite that the first and second shells are longitudinally elongated, and that the shells have internal ribs configured for laterally supporting sharpener components, and that the ribs laterally support the components when they are placed in the first shell. As discussed above with reference to claims 22 and 35, neither Nakazaki nor Chang teach or suggest the claimed invention, in which internal pencil sharpener components are laterally supported by internal ribs of longitudinally elongated shells. In contrast, the ribs of Chang longitudinally and vertically support a pencil sharpener component, but do not provide any lateral support.

For at least this reason, reconsideration and withdrawal of the rejection of claim 42 is respectfully requested.

Claim 45

New claim 45 depends from claim 22 and is likewise patentable for the reasons set forth above for claim 22. In addition, claim 45 recites that each of the internal ribs comprises a first side and a second side opposite the first side, the first and second sides adjoining one of the first and second external shells, and wherein

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each of the support surfaces extends between respective first and second sides of a respective internal rib. Accordingly, each rib extends laterally of the shell, and the support surface is positioned to provide lateral support to a pencil sharpener component. This is neither taught nor suggested by Nakazaki and/or Chang, as discussed above with reference to claim 35. Accordingly, claim 45 is patentable.

Claim 46

New claim 46 depends from claim 35 and is likewise patentable for the reasons set forth above for claim 35. In addition, claim 46 recites that each of the first and second external shells is elongated in a longitudinal direction, and that the first and second pluralities of support surfaces cooperate with each other to laterally position the cutter assembly and gear module in the compartment within the shells.

As discussed above, neither Nakazaki nor teaches nor suggests that the first and second pluralities of support surfaces cooperate with each other to laterally position and fixedly retain said sharpening sub-assembly within said shells, as discussed above with reference to claim 22. Accordingly, claim 46 is patentable.

CONCLUSION

In view of the foregoing amendments and remarks, Applicants believe claims 22-42, 45 and 46 to be patentable and the application in condition for allowance. Applicants respectfully request issuance of a Notice of Allowance. If any issues remain, the undersigned request a telephone interview prior to the issuance of an

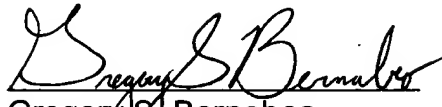
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action.

Respectfully submitted,

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